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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------|------------------|
| 09/408,396   | 09/29/1999  | CHRIS BUHR           | GLIS-0128                 | 4009             |
| 32650                      7590                      11/13/2006<br>WOODCOCK WASHBURN LLP<br>ONE LIBERTY PLACE - 46TH FLOOR<br>PHILADELPHIA, PA 19103 |             |                      | EXAMINER<br>KHARE, DEVESH |                  |
|  |             |                      | ART UNIT<br>1623          | PAPER NUMBER     |

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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CENTRAL REEXAMINATION UNIT

In re Application of :  
Chris Buhr et al. :  
Application No. 09/408,396 : SECOND ORDER TO  
Filed: September 29, 1999 : SHOW CAUSE  
Attorney Docket No. 8GSLIS-0128 :

This is in response to the applicants' communication entitled Response To Order To Show Cause And Petition For Delayed Payment Of Maintenance Fees Pursuant To 37 CFR § 1.378(b) filed June 6, 2006, requesting that prosecution of the above-identified application be continued.

Applicants' response is before the Office of Patent Legal Administration (OPLA) for decision.

### BACKGROUND

1. The present application ("present reissue proceeding") was filed September 29, 1999, for reissue of U.S. Patent No. 5,672,697 (the '697 patent), which issued September 30, 1997.
2. On March 23, 2006, in the present reissue proceeding, the examiner completed examination and prepared a Notice of Allowability for mailing that indicated that claims 1-26 (all of the claims) were allowable. Further, on March 23, 2006, the Notice of Allowability and a Notice of Allowance were mailed.
3. On April 20, 2006, the Technology Center Director withdrew the present application from issue. The issue fee had not been paid.
4. A review of the Office's financial records for the '697 patent reveals that the 3.5 year maintenance fee due and not paid could have been paid during the period from October 2, 2000 (September 30, 2000 was a Saturday) through March 30, 2001, or with a surcharge during the period from April 2, 2001 (March 31, 2001 was a Saturday) through October 1, 2001 (September 30, 2001 was a Sunday). As a result, the '697 patent expired after midnight on September 30, 2001, for failure to pay the 3.5 year maintenance fee due. See 1253 *Official Gazette* 1 (December 4, 2001). Further, the Office financial records reveals that had the '697 patent been subsequently revived, a payment of the 7.5 year maintenance fee due and not paid could have been paid during the period from September 30, 2004 through March 30, 2005, or with a surcharge during the period from March 31, 2005 through September 30, 2005.
5. On May 16, 2006, in the present reissue proceeding, an Order To Show Cause was mailed stating that the '697 patent had expired for failure to pay the first and second maintenance fees, the Director of the USPTO no longer had the authority under 35 U.S.C. § 251 to reissue the '697 patent, and the Office intended to terminate the present reissue proceeding and hold the application for reissue of the '697 patent to be an abandoned

application. Applicants were given a period of 30 DAYS from the mailing of the ORDER to show cause why the Office should not terminate the present reissue proceeding.

6. In response, on June 6, 2006, in the present reissue proceeding, *inter alia*, the present communication entitled Response To Order To Show Cause And Petition For Delayed Payment Of Maintenance Fees Pursuant To 37 CFR § 1.378(b) and an authorization to charge counsel's deposit account for any deficiency associated with the communication were filed. Applicants request that prosecution of the application be continued as the owner of the '697 patent filed on June 6, 2006, the requisite first and second maintenance fees and surcharges along with a petition to accept late payment of the maintenance fee based upon the patent owner's unavoidable failure to timely pay the maintenance fee.

37 CFR 1.181(f) states, in part:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

This provision of the rules is a statement that there is no assurance that any petition filed will be granted. Action shall not be taken based upon an assumption of a future grant of a petition. In this instance, the mere filing of the June 6, 2006 petition did not act to restore the '697 patent to status as a live patent. As such, the '697 patent remains in the status of an expired patent for failure to pay the first and second maintenance fees. Accordingly, the Director of the USPTO does not have the authority under 35 U.S.C. § 251 to reissue the '697 patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993).

As stated in *Morgan*,

"The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only "for the unexpired part of the term of the original patent." Thus, when *Morgan's original patent expired on August 19, 1992, the Commissioner was divested of his reissue authority* because there no longer was an unexpired term of the patent for which *Morgan's patent* could be reissued. *Morgan's appeal thus became moot.*" [990 F.2d at 1231, 26 USPQ2d at 1393; Emphasis added]

Because the Director does not have the authority under 35 U.S.C. § 251 to reissue the patent, at present, it remains proper that the Office terminate the present reissue proceeding, and thereafter hold the application for reissue of the '697 patent to be an abandoned application.

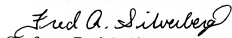
In view of the above, applicants' request that the prosecution of the above-identified application be continued is dismissed, and the June 6, 2006 response to the show cause order of May 16, 2006 is found not to be sufficient to provide basis for examination of the application. The response to the show cause order of May 16, 2006 is, however, sufficient to the extent that the Office will not terminate the present reissue proceeding at this time. Rather, based on the filing of the June 6, 2006 petition to accept late payment of the maintenance fee, jurisdiction over the reissue proceeding is being retained in the Office of Patent Legal Administration (OPLA), to provide the applicants with an opportunity to provide a second showing of cause as to why the Office should not terminate the present reissue proceeding, as will be discussed in the below conclusion.

**CONCLUSION**

1. Applicants are hereby being provided with a period of **SIX(6) MONTHS** from the mailing of this SECOND SHOW CAUSE ORDER to again show cause why the Office should not terminate the present reissue proceeding.
  2. If applicants propose to show cause why the present reissue proceeding should not be terminated, **applicants' showing must include** either:
    - A) A copy of a favorable determination on the merits of the June 6, 2006 petition to accept late payment of the first and second maintenance fees, or
    - B) An explanation of why the proceeding should not be terminated at that point in time even though the original patent has expired.
- Applicants must also show due diligence when providing a response to this SECOND SHOW CAUSE ORDER. If applicants make a showing, the showing will be evaluated as to whether due diligence was exercised in providing the showing, and as to whether the showing provides sufficient basis why the present reissue proceeding should not be terminated.
3. **Failure to respond to this SECOND SHOW CAUSE ORDER within the SIX (6) MONTH period that has been set in this decision will result in the proceeding being terminated by default.** If the present reissue proceeding is terminated by default, jurisdiction over the application for reissue of the '697 patent would then be returned to Technology Center Art Unit 1623 for processing as an abandoned application.
  4. Jurisdiction over the file for reissue application 09/408,396 is being retained in the Office of Patent Legal Administration (OPLA), pending a response by applicants, or the expiration of time for a response.
  5. Telephone inquiries related to this decision should be directed to Fred Silverberg, Senior Legal Advisor, at (571) 272-7719 or, in his absence to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.



Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner for Patent Examination Policy



Conferee: Fred A. Silverberg, Senior Legal Advisor